

Remarks/Arguments

Claims 1-21 are pending. Claim 1 has been amended. Reconsideration of this application in light of the above amendments and the following remarks is requested.

The Office Action fails to address each claim

Applicant submits that the Office action fails to address each claim, as required by MPEP § 706, which states "[i]n rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command.... The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." (emphasis added). For example, the Office action apparently fails to address claims 4, 5, 6, 8, 9, 11, 13, 15, 16, and 18. Accordingly, Applicant requests the issuance of a second Non-Final Office Action that allows or rejects each claim so that Applicant has the opportunity to address any claim rejections that may be raised.

Rejections under 35 U.S.C. § 103(a)

Claims 21-30 stand rejected under 35 U.S.C. § 102(e) as being obvious over U.S. Patent No. 6,122,630 to Strickler ("Strickler") in view of U.S. Patent No. 5,661,803 to Cordery ("Cordery").

A. Combination of references fails to teach or suggest all claim limitations

As provided in MPEP § 2143, "[t]o establish a prima facie case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." Furthermore, under MPEP § 2142, "[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." It is submitted that the Office action does not factually support a prima facie case of obviousness based on Miller for the following reasons.

Claims 1-6

Claim 1, as amended, recites in part updating the values of the writer private key, the authentication token, and the validation token for each additional audit trail record and integrating the updated values of the validation token and the writer public key into each corresponding record of the audit trail.

Strickler fails to teach or suggest the above recited element. For example, nowhere does Strickler teach or suggest updating the values and integrating the updated values into each corresponding record of the audit trail.

The Examiner admits that Strickler fails to teach or suggest validation tokens based on an encryption key pair, and relies on Cordery to remedy this deficiency of Strickler. However, Cordery also fails to teach or suggest the above recited element. Accordingly, the combination of Strickler and Cordery fails to teach or suggest all the claim limitations of claim 1 as required by MPEP § 2143, and claim 1 is allowable over the cited references.

Claims 2-6 depend from and further limit claim 1 and are therefore allowable for at least the same reason as claim 1.

Claims 7-11

Claim 7 recites, in part, integrating into each record a corresponding value of a validation token generated based on a first pair of public-private encryption keys generated by the writer and a second pair of public-private encryption keys generated by the auditor, wherein the auditor has the ability to compute the values of the validation token for the records to verify against the integrated values of the validation token in order to detect a tampering of the audit trail by the access-privileged user.

Strickler and Cordery, whether taken singly or in combination, fail to teach or suggest the above recited element. For example, neither Strickler nor Cordery teach or suggest values of the validation token.

Furthermore, as stated in MPEP 2143.03, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." The Office

action simply refers to "the limitation 'integrating the ... token in the corresponding record of the audit trail.' " and uses Strickler to render this element obvious. (Office action, p. 3, para. 4). The Office action also states that "Strickler also teaches 'comparing the integrated tokens.' " (Office action, p. 3, para. 4). Cordery is then used to disclose that "independent keys are used for generating the digital tokens.... The information and tokens can be verified by a device that processes the information in the same manner and compares the resulting digital tokens with printed on the mail pieces (see column 2, lines 7-2)." (Office action, p. 3, para. 5). Applicant submits that the Office action fails to address each of the words of the above element as required.

Accordingly, the combination of Strickler and Cordery fails to meet the standard presented by MPEP § 2143, and claim 7 is allowable over the cited references. Claims 8-11 depend from and further limit claim 7 and are therefore allowable for at least the same reason as claim 7.

Claims 12-21

Independent claims 12 and 17 include elements similar to those of claim 7 and are allowable for at least the same reason as claim 7. Claims 13-16 and 18-21 depend from and further limit either claim 12 or 17, and are therefore also allowable.

B. There is no motivation to combine the references

Furthermore, even if the combination of Strickler and Cordery taught or suggested each element of each claim (which it clearly does not, as described above), the case law is clear that there must be evidence that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. It is also clear that a rejection cannot be predicated on the mere identification of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner

claimed. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000) (emphasis added). The Examiner states "[o]ne of ordinary skill in the art would have been motivated to modify the system for auditing the changes to a database by comparing the validation tokens by having the tokens based on different cryptographic key pairs as taught in Cordery for generating digital tokens. (see Cordery, column 2, lines 10-12). However, the cited text of Cordery merely states that "[i]n each digital meter, independent keys are used for generating the digital tokens. For security reasons, the keys in different meters are also independent." Applicant submits that the Examiner has submitted no evidence or particular findings to support his conclusion as required.

Additionally, although Applicant strongly disagrees that the combination of Strickler and Cordery teaches or suggests each claim, even if it did, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01. "A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references." MPEP § 2143.01 (emphasis original). Here, not only has the Examiner stated no objective reason to combine the references (as described in the preceding paragraph), but the references fail to even show all aspects of the claimed invention as required.

Therefore, the combination of references is improper and claims 1-21 are allowable over the cited art.



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Conclusion

Accordingly, Applicant respectfully submits that independent claims 1, 7, 12, and 17 are in condition for allowance. Dependent claims 2-6, 8-11, 13-16, and 18-21 depend from and further limit their respective independent claims and are also in condition for allowance. Should the Examiner have any further comments, the Examiner is invited to contact the Applicant at the below listed number.

Respectfully submitted,

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